

REMARKS

Favorable reconsideration is respectfully requested in view of the foregoing amendments and the following remarks.

With regard to the restriction requirement, Applicants respectfully request that the Examiner reconsiders her position in view of the following remarks.

Applicants submit that the subject matter of claims 34-54 are directed to a single inventive concept and so the restriction requirement is improper under PCT practice. Applicants believe that claims 50-52 do not lack unity with the claims of elected Group I since they are directed to proteins, polypeptides and the like derived from the sequences recited in the Group I claims. In other words, claims 50-52 are directed to products of the claimed nucleotide sequences which are the subject matter of the elected claims. Likewise, claims 53 and 54 are directed to antibodies which are also products of the claimed nucleotide sequences. Thus, in view of the fact that the claims are to a single inventive concept (i.e. nucleotide sequences and products encoded by these nucleotide sequences), it is respectfully submitted that the restriction requirement be withdrawn.

With regard to the rejection of claims 36-49 under 35 U.S.C. §112, first paragraph, this rejection is deemed to be untenable and is thus respectfully traversed.

The Examiner has based this rejection on the fact that the specification fails to disclose the washing conditions for hybridization. The Examiner notes in the Official Action that although page 9 of the specification discusses hybridization, only the preferred conditions for moderate and high stringency incubations are described. However, Applicants respectfully wish to draw the Examiner's

attention to the paragraph bridging pages 17 and 18 of the specification. In this cited passage, the washing conditions are described as follows:

"Subsequent washes were carried out for a total of 1 hour in three changes of either 0.5 x SSC (75 mM NaCl/7.5mM sodium citrate (pH 7.5))/ 0.1% SDS at 65°C (high stringency) or 1 x SSC/0.1% SDS at 45°C (low stringency)."

In view of the fact that the washing conditions are disclosed in the specification, Applicants respectfully submit that this rejection cannot be sustained and should be withdrawn.

With regard to the rejection of claims 36-49 under 35 U.S.C. §112, second paragraph, this rejection is also deemed to be untenable and is thus respectfully traversed.

The Examiner has argued on page 4 of the Official Action that claims 36-41 are indefinite since they fail to specifically recite the hybridization conditions, particularly the washing conditions. However, Applicants submit that since these conditions are defined and described in the specification, it is unnecessary to recite these conditions in the claims.

First, since one skilled in the art would know whether hybridization, under any conditions, would have occurred in a hybridization assay, a further description is not required in the claims. In addition, since hybridization (low to moderate to high stringency) is also an area which is well known and understood by one skilled in the art, specific hybridization conditions need not be recited in the claims in order to satisfy the definiteness requirement under 35 U.S.C. §112, second paragraph. In other words, the phrase "moderate to high stringency" contained in the claims is already definite under 35 U.S.C. §112, second paragraph, since one skilled in the art clearly understand the metes and bounds of such claim language.

Furthermore, under U.S. practice, the meaning of the claims is not read in a vacuum but in light of the teachings of the specification. Applicants note that the terms "moderate to high stringency" are clearly defined as follows on page 9, lines 13-15, of the specification.

"Moderate stringency as defined above corresponds with about 75% homology. High stringency as defined above corresponds with about 90% homology."

Applicants also note that specific examples of hybridization conditions for moderate and high stringency are clearly set forth on page 9, lines 3-11, of the specification. Likewise, as stated earlier, the washing conditions for hybridization are also clearly specified on pages 17 and 18 of the specification. Applicants believe that if a person skilled in the art was unsure as to the meaning of the phrase "moderate to high stringency" as used in claims 42-49, he or she would review the teachings of the specification to understand the meaning of the phrase. Thus, since the phrase is clearly defined in the specification, one skilled in the art would not be left uncertain as to the "metes and bounds" of the present invention.

With regard to the rejection of claims 36, 37 and 42-47 under 35 U.S.C. §102(b) as being anticipated by Delmas et al., this rejection is deemed to be untenable and is thus respectfully traversed.

To constitute anticipation of the claimed invention, a single prior art reference must disclose each and every material element of the claim. Here, in this case, the polynucleotide of Delmas et al. is clearly outside the scope of the claims. As stated earlier, the phrase "moderate to high stringency" is specifically defined on page 9, lines 13-15, of the specification as corresponding to about at least 75% homology. The Delmas et al. polynucleotide has only a 66.7% homology to SEQ ID No: 2, 44.1% homology to SEQ ID No: 3, 45.6% homology to SEQ ID No: 4, 45.1% homology to SEQ ID

No: 5, 51.4% homology to SEQ ID No: 10 and 67.2% homology to SEQ ID No: 15, all of which falls well outside the scope of the claims (i.e. about at least 75% homology).

Further, Applicants wish to note that on page 5, lines 16-22, of the specification, it states that:

"The present invention does not, however, extend to any known protein or fragment thereof or polypeptide or nucleic acid or fragment thereof or oligonucleotide containing a CHD-gene related sequence such as the *Saccharomyces cerevisiae* SNF2/SWI2 gene, *Drosophila polycomb* and HPI genes described below, insofar as that protein or fragment, polypeptide, nucleic acid or fragment or oligonucleotide is known *per se*.

Since a polynucleotide is an example of an oligonucleotide, Applicants submit that the specification does in fact explicitly define a "fragment" to include a polynucleotide. Moreover, the description positively disclaims sequence known *per se* at the time of the filing of the application.

The sequences described in the Delmas et al reference are discussed in detail on page 24, line 9 to page 25, line 13 of the specification and thus were well known to the inventors at the time the application was filed. Hence, the sequences described by Delmas et al. which are known *per se* effectively fall within the disclaimer and outside the scope of the claims.

Thus, Applicants submit that claims 36, 37 and 42-47 are novel over the teachings of Delmas et al. and that the rejection under 35 U.S.C. §102(b) in view of Delmas et al should be withdrawn.

In view of the foregoing amendments and remarks, it is respectfully submitted that the Application is now in condition for allowance. Such action is thus respectfully solicited.

If, however, the Examiner has any suggestions for expediting allowance of the application or believes that direct communication with Applicants' attorney will advance the prosecution of

this case, the Examiner is invited to contact the undersigned at the telephone number below.

Respectfully submitted,

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